



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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AUG 12 2002

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 17, 47 and 49 of the morning section and questions 27, 33, 41 and 48 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On January 29, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only

answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 17, 47 and 49 and afternoon questions 27, 33, 41 and 48. Petitioner's arguments for these questions are addressed individually below.

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

Morning question 17 reads as follows:

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

(A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.

(B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.

(C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.

(D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.

(E) None of the above.

The model answer is selection (C).

35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted's application. (D) is incorrect

because the foreign patent application issued after the date of Ted's application.  
35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

The petitioner argues that answer (E) is the most correct because it refers to answers (B), (C) and (D), which petitioner contends are all equally correct answers. Petitioner states that answer (B) is a correct answer because the reference described qualifies as prior art under 35 U.S.C. § 102(e). Petitioner also states that answer (D) is a correct answer because the reference described qualifies as prior art under 35 U.S.C. § 102(a).

Petitioner's arguments have been fully considered, but are not persuasive. Although petitioner correctly states that the reference described in answer (B) can be a prior art reference under 35 U.S.C. § 102(e), the question asked which reference is a "statutory bar under § 102."<sup>1</sup> Only references that qualify as prior art under 35 U.S.C. § 102(b) or (d) can be "statutory bars under § 102." See MPEP 706.02(a) and 706.02(e). Therefore, answer (B) is not a correct answer to the question asked. In regards to answer (D), the reference described is not a prior art reference under § 102(a) because the reference was published (April 12, 2000) after the effective filing date of the application (March 15, 2000). Even assuming the reference in answer (D) was proper prior art under § 102(a), the reference would not create a statutory bar. Therefore, answer (D) is not a correct answer to the question asked. Accordingly, answer (E) ("None of the above") is not a correct answer because answer (C) does describe a reference that can be a statutory bar under § 102.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 47 reads as follows:

47. Registered practitioner Rick drafted a patent application for inventor Sam. The application was filed in the USPTO on May 15, 2000, with a power of attorney appointing Rick. On March 15, 2001, Sam filed a revocation of the power of attorney to Rick, and a new power of attorney appointing registered practitioner Dave. In a non-final Office action dated September 12, 2001, the examiner included a requirement for information, requiring Dave to submit a copy of any non-patent literature, published application, or patent that was used to draft the application. Which of the following, if timely submitted by Dave in reply to the requirement for information, will be accepted as a complete reply to the requirement for information?

(A) A statement by Dave that the information required to be submitted is unknown and is not readily available to Dave.

(B) A statement by Dave that the requirement for information is improper because it was included in a non-final Office action.

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<sup>1</sup> The petitioner should note that entire phrase "statutory bar under § 102" must be read together because there are other sections of the United States Code (e.g. § 135(b)) that create statutory bars.

(C) A statement by Dave that the requirement for information is improper because Dave is not an individual identified under 37 CFR 1.56(c).

(D) A statement by Dave that the requirement for information is improper because information used to draft a patent application may not be required unless the examiner identifies the existence of a relevant database known by Sam that could be searched for a particular aspect of the invention.

(E) None of the above.

The model answer is selection (A).

37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR 1.105(b). (C) is incorrect because 37 CFR 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR 1.105. (E) is incorrect because (A) is correct.

The petitioner argues that answer (E) is the best answer because answer (A) is incorrect. The petitioner asserts that Rick and Sam, in addition to Dave, have an obligation to reply to the request for information because they are parties defined in 37 CFR 1.56. Therefore, the petitioner explains that Dave's reply alone would not be a sufficient reply.

Petitioner's arguments have been fully considered, but are not persuasive. Although petitioner correctly states Rick and Sam are parties defined in 37 CFR 1.56, Rick and Sam are not obligated to provide a separate reply to the request for information. Generally, the Office communicates only with one party during the prosecution of the application. See MPEP 403. Although Dave must make a good faith effort to obtain the requested information, which may involve contacting Rick and Sam, question 47 does not address that issue. The question asks "Which of the following, if timely submitted by Dave in reply to the requirement for information, **will be accepted as a complete reply** to the requirement for information?" (emphasis added). The question is only asking what reply will be accepted by the Office as a complete reply. Answer (A) will be accepted as a complete reply by the Office without any further replies by Rick and Sam. This policy is set forth in 37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). The Office does not require a showing of efforts made to obtain the information nor a reply by each 37 CFR 1.56(c) party. The statement that the information required to be submitted is unknown and not readily available is generally accepted "on its face." Therefore, answer (A) is the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. Joe files a nonprovisional patent application containing claims 1 through 10 in the USPTO and properly receives a filing date of December 6, 2000. The first Filing Receipt including a confirmation number for the application was mailed on December 20, 2000. On January 30, 2001, the examiner mails Joe a NOTICE indicating that a nucleotide sequence listing in accordance with 37 CFR 1.821-1.825 is required. On February 27, 2001, Joe files the required sequence listing as well as a preliminary amendment adding claims 11 through 13 to the application, along with a copy of the application as amended in compliance with the Office electronic filing system requirements. Assuming the Office has not started the publication process at such time and that Joe's application is subsequently published pursuant to 35 U.S.C. § 122(b), which of the following statements accords with proper USPTO practice and procedure?

(A) The published application will contain claims 1 through 10 only because the preliminary amendment adding claims 11 through 13 was not submitted in reply to the NOTICE.

(B) The published application will contain claims 1 through 13 because a copy of the application as amended in compliance with the Office electronic filing system requirements was filed.

(C) The published application will contain claims 1 through 10 only because the copy of the application as amended in compliance with the Office electronic filing system requirements was not filed within one month of the actual filing date of the application.

(D) The published application may contain claims 1 through 13 because the Office may use an untimely filed copy of the application as amended in compliance with the Office electronic filing system requirements where the Office has not started the publication process.

(E) The published application will contain claims 1 through 10 only because publication is based solely on the application papers deposited on the filing date of the application.

The model answer is selection (B) and (D).

(B) and (D) are correct and (A), (C), and (E) are wrong. 37 CFR 1.215 (“(c) At applicant’s option, the patent application publication will be based upon the copy of the application...as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing

date for which a benefit is sought under title 35, United States Code, whichever is later. (d)... If... the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.”). The Office in a notice (“Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes”) in the Official Gazette on December 26, 2000, (1241 O.G. 97) advised that an electronic filing system (EFS) copy of an application will be used in creating the patent application publication even if it is submitted outside the period set forth in 37 CFR 1.215(c), provided that it is submitted within one month of the mailing date of the first Filing Receipt including a confirmation number for the application. While the published application is based on the application as originally filed, if applicant submits an amended version of the application via EFS within the time period set forth in section 1.215(c), the amended version of the application will be used for the publication. Based on the facts given in the question, the amended version of the application was timely filed within the fourteen-month window because the earliest filing date for which a benefit is sought is the filing date (December 6, 2000) of the application. Answers (A), (C) and (E) are all wrong because each answer states that the published application will only include claims 1-10, however, the publication will include claims 1-13 filed with the EFS submission.

The petitioner argues that answer (C) is the best answer because petitioner claims there is no evidence that applicant wanted the amended application to be published in the facts of the question. Therefore, the original application as filed will be published so answer (C) is the most correct answer.

Petitioner’s arguments have been fully considered, but are not persuasive. In the question, Joe did chose to have the amended application published through his act of filing the amended application via EFS. If applicant submits an amended version of the application via EFS within the time period set forth in section 1.215(c), the amended version of the application will be used for the publication. See 1241 O.G. 97 (Dec. 26, 2000). Currently, pre-grant publication is the only reason to file an amended application via EFS. Since Joe did timely exercise his option under 37 CFR 1.215(c), answer (C) is not a correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary’s name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean where the only communication is in the summer months. Sam, the father of Mary, has



been authorized by Mary to sign Mary's name to the § 1.63 declaration and also Sam's name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

(A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.

(B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.

(C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.

(D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.

(E) Sam may sign Mary's name to the declaration since he was authorized by Mary to do so.

The model answer is selection (E).

(E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word "made" implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). (A) contains the elements of 37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(I), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorized Sam to inspect the provisional application.

The petitioner argues that answer (B) is the best answer because Mary could appoint her father to represent her under state laws pertaining to powers of attorney. Therefore, petitioner contends that answer (E) is in accordance with proper USPTO procedure and answer (B) is not.

Petitioner's arguments have been fully considered, but are not persuasive. State laws regarding powers of attorney do not extend to federal patent law. The controlling federal law is that the inventor or inventors must sign the oath or declaration pursuant 35 U.S.C. §§ 115, 116, 117 and 118. Sections 116-118 describe certain exceptions where another can sign for an inventor, but none of those exceptions apply to the fact pattern in the question. Therefore, Mary could not have properly authorize Sam to sign the declaration on her behalf. Accordingly, answer (E) is the answer that is not in accordance with proper USPTO procedure, and therefore, is the most correct answer to the question.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

(A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.

(B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.

(C) Traverse the rejection arguing that the examiner does not create a prima facie case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.

(D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.

(E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

The petitioner argues that answer (B) is the most correct answer. The petitioner contends that since patent term is measured from the filing date, it may be best to anticipate a future rejection of the claim under 35 U.S.C. § 103 and amend the claim to avoid that anticipated rejection. This action, petitioner argues, would save time and money in the prosecution of the application.

Petitioner's arguments have been fully considered, but are not persuasive. Although petitioner may be correct that amending the claims may lead to a more compact prosecution of the application, the answer does not follow the client's instructions in the question. The question specifically states that "Sonny informs you that you should not narrow the scope of the claims unless **absolutely** necessary to overcome the rejection." The amendment in answer (B) would narrow the scope of the claims as it adds an element that was not previously claimed. In addition, the amendment may not be necessary as there is no indication in the question that such a rejection would be a proper prima facie showing under 35 U.S.C. § 103(a). Petitioner is reminded not to assume facts not presented in the fact pattern. Furthermore, as discussed in the model answer, answer (D) is a proper reply to the Office action, which is also consistent with the client's instructions.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with USPTO proper practice and procedure?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

The model answer is selection (C).

Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

The petitioner argues that answer (B) is the best answer because petitioner contends that the reissue is not a broadening reissue, and that answer (C) is not correct because it lacks the consent of the assignee. Petitioner states that the reissue is not broadened because only one claim element was broadened while five other claims elements were narrowed. Therefore, petitioner argues that the claim was not, in fact, broadened.

Petitioner's arguments have been fully considered, but are not persuasive. A broadened reissue claim is a claim that enlarges the scope of the claims of the patent. See MPEP 1412.03. In addition, "[a] claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in

other respects.” MPEP 1412.03. The fact pattern clearly indicates that the claim of the reissue application broadened one of the claim elements, e.g., it is broader in at least one respect. Therefore, the reissue is a broadening reissue that must be filed by the inventor in accordance with proper USPTO procedure. Petitioner did correctly state that the consent of the assignee is required. However, the consent of the assignee is not required upon filing. See MPEP 1410.01. Accordingly, answer (C) is the most correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor’s patent that Acme fears might cover Acme’s key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor’s December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent’s validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme’s costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme’s prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme’s prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

The model answer is selection (C).

Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. See, e.g., 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

The petitioner argues that answer (D) is the best answer, or no answer is appropriate, for the following three reasons. First, petitioner states answer (D) is a better answer than answer (C) because answer (C) does not avail itself to the public sale evidence. Petitioner contends that such evidence might be published or otherwise available in sales or promotional literature. Second, petitioner further argues that the preview of this question exceeds the scope of the examination in as the question is asking for legal advice. Third, petitioner contends that the facts of the questions do not make clear that the publication in the trade journal is prior art because the publication is not prior art under 35 U.S.C. § 102(b) and may not be prior art under § 102(a), depending on what the ultimate date of invention is.

Petitioner's arguments have been fully considered, but are not persuasive. In regards to petitioner's first argument, petitioner is assuming that the evidence of public sale is published. Petitioner is reminded that the instructions of the examination state not to assume facts not present. The categories of evidence of "know or used by others" in § 102(a) or public sale in § 102(b) are distinct from the category of "printed publication." The facts of the questions set forth that the evidence of public sale was not in a printed publication within the meaning of § 102(a) or (b). Therefore, such evidence cannot be the basis for a request for reexamination. In regards to petitioner's second argument, the question is not outside the scope of the examination because it is asking for reasonable options pertaining to procedures before the USPTO. The question does not ask for advice about litigation as the question specifically excludes that option by the statement "options short of litigation." In regards to petitioner's third argument, the trade magazine publication is prior art under 35 U.S.C. § 102(a) as it was published prior to the filing of the application that issued as the patent in question. The fact that the patent applicant may attempt to swear behind the reference by establishing the date of invention prior to the filing date is not relevant to this question. Petitioner is reminded that the instructions of the examination state not to assume facts not present. Accordingly, answer (C) is the most correct answer provided.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

## **ORDER**

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is **ORDERED** that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy